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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,070	03/22/2004	Johannes Theodorus Maria Slingerland	VER-180XX	1513

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WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP
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BOSTON, MA 02109

EXAMINER

NGUYEN, TRINH T

ART UNIT	PAPER NUMBER
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3644

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/806,070

Applicant(s)

SLINGERLAND ET AL.

Examiner

Trinh T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE dated 11/14/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 12, 15, 17-19 and 21-41 is/are pending in the application.
- 4a) Of the above claim(s) 23-26 and 31-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 12, 15, 17-19, 21, 22, 27-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination under 37 CFR 1.114 After Final Rejection

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/14/06 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,2,4-6,12,15,17-19,21,22,28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by JP1-108926 (JP'926).

For claim 1, JP'926 discloses a flower box assembly comprising an inner box (2) and a first inner box holder (1), the inner box having a bottom wall and at least one closed sidewall, the first inner box holder having at least one sidewall and an open lower side and upper side, the inner box being detachably coupled with the inner box holder.

For claim 2, JP'926 further discloses a second inner box holder having at least one sidewall and an open lower side and upper side.

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For claims 4, 21 and 22, JP'926 further discloses that at least one sidewalls of the first and second inner box holders are tapered.

For claim 5, JP'926 further discloses that at least one sidewall of the inner boxes tapered.

For claim 6, JP'926 further discloses that in the at least one sidewall of the first inner box holders, at least one light passage opening (4).

For claim 12, JP'926 further discloses the second and first inner box holders with lower edges.

For claim 15, JP'926 further discloses the first inner box holder is provided with at least on toothed provision (8).

For claim 19, JP'926 further discloses the inner box or first inner box holder is provided with engagement means (5,6,7).

For claim 28, JP'926 further discloses the first inner box holder with a circumferential projection (5).

For claim 29, JP'926 further discloses a circumferential projection (2b) on an end of the inner box.

Regarding the intended use of the first and second box holders and the inner box as claimed in claims 1,2,4-6,12,15,17,18,21,22,28-30, it is noted that it is well settled case law that such limitations (for example only, "the inner box being detachably coupled with the inner box holder", "suitable to accommodate the inner box...when the second inner box holder rests on the upper side of the first inner box holder", "the first inner box holder is nestable within another", "the inner boxes is nestable within another",

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"is designed such that...for stable stacking", "to permit stacking...in a stable manner", "can be detachably coupled...in relation to the inner box", "extends substantially within...in the second relative position", "which are arranged...a weight of the first inner box holder", "the inner box is placeable in the first inner box holder", "which engages an edge...of the second inner box holder", "which is shaped and sized...placeable atop the second inner box holder"), which are essentially method limitations or statements or intended or desired use, do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 152 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647; and MPEP 2114 & 2115. MPEP 2114 which states: A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claims. Ex parte Masham, 2 USPQ2d 1647.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP1-108926 (JP'926).

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As described above, JP'926 discloses most of the claimed invention except for mentioning that the second inner box holder different from the first inner box holder. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made that whether the second inner box holder is different from or the same as the first inner box holder is a matter of design choice wherein no significant problem is solved or unexpected result obtained, and it appears that the invention would perform equally well with the first and second inner box holders such as one taught by JP'926.

Regarding the intended use of the first and second box holders and the inner box, it is noted that it is well settled case law that such limitations (i.e., "can be detachably coupled...in an inverted, second position", "extends substantially...in the second position", "are arranged to detachably...a weight of the first inner box holder"), which are essentially method limitations or statements of intended or desired use, do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 152 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2d 1647; and MPEP 2114 & 2115. MPEP 2114 which states: A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claims. Ex parte Masham, 2 USPQ2d 1647.

Response to Arguments

6. Applicant's arguments filed 11/14/06 have been considered but are moot in view of the new ground(s) of rejection.


7. In response to Applicant's remarks on Election/Restrictions, it is noted that the only proper traverse to an election of species requirement is to state that the species are not patentably distinct. If the Applicant(s) wish to do so, they, and their admission that one species is not patentably distinct over the other, will provide an express admission that a rejection of one species necessarily is a rejection of all species. Furthermore, it is noted that an additional set of claim would require additional searches and thus it would be a serious burden on the Examiner.

Conclusion

8X. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trinh T. Nguyen whose telephone number is (571) 272-6906. The examiner can normally be reached on M-F (9:30 A.M to 6:00 P.M). The examiner's supervisor, Teri Luu can be reached on (571) 272-7045 for the purpose of status inquiry only. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Trinh T Nguyen
Primary Examiner
Art Unit 3644

1/24/07